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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,694	11/25/2003	William T. Ball	P06474US3	6303
34082	7590	03/24/2005	EXAMINER	
ZARLEY LAW FIRM P.L.C. CAPITAL SQUARE 400 LOCUST, SUITE 200 DES MOINES, IA 50309-2350			PRUNNER, KATHLEEN J	
			ART UNIT	PAPER NUMBER
			3751	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SN

Office Action Summary

Application No.

10/721,694

Applicant(s)

BALL, WILLIAM T.

Examiner

Kathleen J. Prunner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Reopening Prosecution

1. In view of the appeal brief filed on January 6, 2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, (A) the “drain pipe having an inverted L-shape”, as called for by claim 1; (B) the “drain pipe ... including a horizontal leg extending into and through the overflow port of the bathtub, and a vertical leg extending downwardly for connection to a fluid drain system”, as called for by claim 1; (C) the “fluid drain system”, as called for by claim 1; (D) “a pipe having a first exposed end and second end in communication with a fluid source, wherein the first end comprises a threaded portion”, as called for by claim 2; (E) “a plumbing test system”, as called for by claim 2; (F) “a pipe having a first exposed end and second end in communication with a fluid source, wherein the first end comprises a threaded portion”, as called for by claim 2; (G) “the cap assembly” being “composed of a material capable of sealing the first end when the cap is threaded onto the first

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end”, as called for by claim 2; (H) “the cap assembly contains a cap”, as called for by claim 2; and (I) the “sealing member secured to the cap”, as called for by claim 2, must be shown or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended”. If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as “Annotated Sheets” and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed terminology. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The claim terminology which lacks such antecedent basis is as follows: (A) the “drain pipe having an inverted L-

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shape”, as called for by claim 1; **(B)** the “drain pipe ... including a horizontal leg extending into and through the overflow port of the bathtub, and a vertical leg extending downwardly for connection to a fluid drain system”, as called for by claim 1; **(C)** “threads on the horizontal leg extending through the overflow port”, as called for by claim 1; **(D)** the cap “threadably mounted on an end of the horizontal leg extending through the overflow port”, as called by claim 1; **(E)** the cap “having an opening in its circular planar end”, as called for by claim 1; **(F)** “a flexible” sealing membrane, as called for by claim 1; **(G)** the sealing membrane being “secured to the cap”, as called for by claim 1; **(H)** the sealing membrane “extending over the opening in the circular planar end” of the cap, as called for by claim 1; **(I)** “a plumbing test system”, as called for by claim 2; **(J)** “a pipe having a first exposed end and second end in communication with a fluid source, wherein the first end comprises a threaded portion”, as called for by claim 2; **(K)** “a cap assembly”, as called for by claim 2; **(L)** the “cap assembly threadably mounted on the first end and wherein a portion of the cap assembly is composed of a material capable of sealing the first end when the cap is threaded onto the first end”, as called for by claim 2; **(M)** “the cap assembly contains a cap”, as called for by claim 2; **(N)** “a cap having an opening in a planar end”, as called for by claim 2; **(O)** “a sealing member”, as called for by claim 2; **(P)** the sealing member being “secured to the cap”, as called for by claim 2; and **(Q)** the sealing member “extending over the opening in the planar end”, as called for by claim 2. Correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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7. Claim 2 contains a term lacking proper antecedent basis. The claim recites the limitation “the cap” in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Delanoy. Delanoy discloses a plumbing test system (note lines 9-13, 70-76 and 85-88 on page 1) having all the claimed features including a pipe 1 having a first exposed end and a second end in communication with a fluid source (note lines 9-16 on page 1) wherein the first end comprises a threaded portion 3 (note Fig. 2); a cap assembly 6 threadably mounted on the first end and wherein a portion 10 of the cap assembly is composed of a material capable of sealing the first end (note lines 9-12 on page 1) when the cap is threaded onto the first end (note lines 70-73 on page 1); the cap assembly 6 contains a cap 7 having an opening in a planar end (note lines 59-62 on page 1) with a sealing member 10 secured to the cap 7 and extending over the opening in the planar end (note lines 56-62 on page 1).

Claim Rejections - 35 USC § 102 and 103

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. The following is a quotation of 35 U.S.C. 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 1 is rejected under 35 U.S.C. 102(b) or 103(a) as being unpatentable over Ball. Ball discloses an overflow system for a bathtub 18 which has a bottom or base 26, adjacent side walls 22 and end walls 24 (note Fig. 2), a drain port 28 in the bottom 26, and an overflow port 30 in one of the end walls 24 having the claimed features including a drain pipe (constituted by pipes 32, 34, 36 and 38) adapted to be in communication with the drain port 28 and the overflow port 30 (note Fig. 2), the drain pipe 34 having an inverted L-shape including a horizontal leg extending into and through the overflow port 30 of the bathtub 18 (note Fig. 2) and a substantially vertical leg 34 extending downwardly for connection to a fluid drain system; and a cap (constituted by plate 70) threadably mounted (via screws 78) on an end of the horizontal leg extending through the overflow port 30 (note Figs. 1 and 2); the cap 70 having an opening 72 in its circular planar end (note Fig. 4) with a thin flexible sealing membrane (constituted by flexible diaphragm 64) secured to the cap 70 (via screws 78) and extending over the opening in the circular planar end (note Fig. 4). Ball further discloses that the cap 70 is mounted on the horizontal leg of the drain pipe 34 by the use of screws 78 which connect to the tabs 56 and 58 on the horizontal leg (note lines 30-46 in col. 2). Since the screws 78 of Ball are inherently threaded, it is considered that the perforations in tabs 56 and 58 (note Fig. 6) which engage the screws 78 are likewise inherently threaded.

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Delanoy in view of Lewis. Delanoy is applied as mentioned in paragraph 8 supra. Delanoy discloses that the cap assembly 6 is screwed into the piping (note lines 9-12 on page 1). Although Delanoy fails to disclose that the cap assembly 6 is screwed onto the outer threads of the pipe, attention is directed to Lewis who discloses another plumbing bathtub test system (note ¶ 0008) having a cap assembly (constituted by test plug 8) which can be threadably mounted to the pipe elbow 20 either via outer screw threads or inner screw threads (note ¶ 0020). It would have been obvious

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to one of ordinary skill in the plumbing bathtub test system art, at the time the invention was made, to substitute for the inner screw mounting of the cap assembly into the pipe of Delanoy, the outer screw mounting of the cap assembly onto the pipe as, for example, taught by Lewis wherein so doing would amount to mere substitution of one screw attachment mechanism for another that would work equally well in the Delanoy device.

Response to Arguments

14. Applicant's arguments filed January 6, 2005 have been fully considered but they are not deemed persuasive.

15. Applicant's arguments with respect to claim 2 and the Delanoy reference have been carefully considered. However, the claim does not recite a cap "that screws onto threads 31 that are on the outside of a pipe 34". The claim merely calls for "the cap assembly to be threadably mounted on the first end of the pipe 34" which is exactly what the Delanoy reference does, i.e., it is mounted on the first end as opposed to being mounted on the opposite end of the pipe.

16. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a cap that screws onto threads 31 that are on the outside of a pipe 34) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

17. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Kathleen J. Prunner, whose telephone number is 571-272-4894. The examiner can normally be reached on Monday through Friday, 5:30 AM to 2 PM.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu, can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JUSTINE R. YU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

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Kathleen J. Prunner

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March 19, 2005